

REMARKS

Claims 9-11, 13-30 and 32-40 are pending in the above-identified application, claim 31 having been withdrawn from consideration. Claims 9-11, 13-30, and 32-40 were rejected under 35 U.S.C. § 112, second paragraph. Applicants respectfully request reconsideration of the claims in light of the amendments and remarks made in this response.

With this response, claims 9, 11, 32 and 39 have been amended and claim 31 has been canceled. Support for these amendments can be found throughout the specification, for example, at page 6, lines 11-25; and page 7, lines 17-26. In addition, claims 13-30 and 32 were amended to correct a typographical error. None of these amendments adds new matter. Their entry is respectfully requested.

Interview

Applicants thank Examiner Berch for the courtesy of a telephone interview with their attorney, Mary J. Edwards, on November 27, 2006, to discuss the rejection under 35 U.S.C. § 112, second paragraph, described in more detail in this response. During the interview amendments which would put the claims in a condition for allowance were discussed. Applicants submit that the amendments set forth above accurately summarize those discussed during the interview.

Rejection Under 35 U.S.C. § 112

Claims 9-11, 13-30, and 32-40 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicants regard as the invention. Specifically, the Office Action contends that the term “organic tertiary base” is indefinite. (Office Action at p. 2).

For reasons of record, Applicants respectfully disagree and submit that the term provides the requisite degree of clarity and particularity. MPEP § 2173.02. Nevertheless, solely in an effort to expedite prosecution, Applicants have amended claims 9, 11, 32, and 39 to include the term “amine” following “tertiary” in the above phrase. Accordingly, the phrase now reads “organic tertiary amine base.” Applicants submit that the claims are definite and respectfully request that the rejection under 35 U.S.C. § 112, second paragraph be withdrawn.

Double Patenting

Claims 1-6, 8-30, and 32-42 stand provisionally rejected on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31, 33-40 of copending U.S. Patent Application No. 10/427,666 ("the '666 Application"). Applicants disagree and submit that this rejection is not proper.

Although the instant application claims priority to the '666 Application as a continuation-in-part application, it is in effect a divisional application of the '666 Application. The added subject matter in the instant application includes additional experimental examples. In addition, the as-filed claims of the instant application are similar in scope to those of the '666 Application. A Restriction Requirement issued in the '666 Application, restricting the claims to three classes: claims 1-31 (reductive elimination process), claim 32 (product), and claims 33-40 (cyclization process). A similar Restriction Requirement was also issued in the instant application. The pending claims of the instant application are directed towards non-elected subject matter from the '666 Application. Likewise, the pending claim of the '666 Application is directed towards non-elected subject matter from the instant application. Accordingly, there is no risk of double patenting, as the two applications seek allowance of independent and distinct claims, as evidenced by the duplicative Restriction Requirements in both cases.

Moreover, 35 U.S.C. 121 prohibits the use of a parent application or patent as a reference against a divisional application where a restriction has been made. *See also* MPEP §804.01. Applicants submit that the claims of the two applications are consonant with the Restriction Requirements made by the Examiner. Applicants further submit that the Restriction Requirement issued in the instant application provides evidence that the line of demarcation between the independent and distinct inventions identified in the Restriction Requirement of the '666 Application has been maintained. Accordingly, applicants submit that the double patenting rejection is improper under the prohibition of 35 U.S.C. 121 and request that it be withdrawn.

In addition, the MPEP requires that every Office Action containing a rejection on the ground of double patenting which relies on the parent application rejecting the claims of a divisional or continuing application be submitted to the Technology Center Director for approval. MPEP § 804.04. The prosecution history provides no evidence of such approval.

Applicants are prepared to file a Terminal Disclaimer in the event that it is determined one is required. However, for reasons provided above, Applicants submit that a Terminal Disclaimer is not required and request that the double patenting rejection be withdrawn.

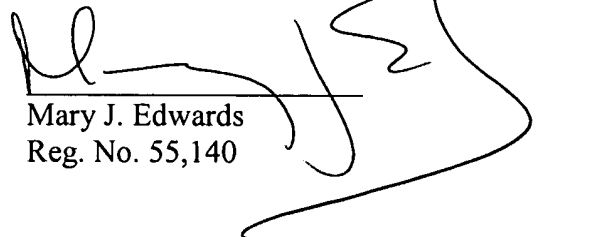
Conclusion

In view of the foregoing amendment and remarks, Applicants submit that all pending claims are in condition for allowance, which action is earnestly solicited.

Applicants respectfully request an early and favorable reconsideration and issuance of this application as amended herein. The Examiner is encouraged to contact the undersigned to expedite prosecution of this application.

No fees are believed to be due in connection with this submission. However, if any fees are due in connection with this application, the Director is hereby authorized to charge any fees due, or credit any overpayment, to Wilmer Cutler Pickering Hale and Dorr LLP Deposit Account No. 08-0219.

Respectfully submitted,



Mary J. Edwards
Reg. No. 55,140

Date: November 29, 2006

Wilmer Cutler Pickering
Hale and Dorr LLP
60 State Street
Boston, Massachusetts 02109
Telephone: (617) 526-6215
Facsimile: (617) 526-5000